

Attachment to the Advisory

Claims as amended by the applicants incorporated limitations of objected claims into independent claim 1 or rendered dependent claim an independent.

During review of the claims the examiner found several discrepancies. However due to complicated nature of the amendment, it was agreed that an advisory action should be issued so that the applicants can correct the claims.

The amendments discussed were as follows:

Claim 1, line 1, to delete (I). Applicants are also requested to insert definition of L_3 into claim 1.

Claim 3 to be cancelled.

Claim 6 refers to formula IVa, which is not a limitation of independent claim 1. Formula IVa is distinct from formula II, since it requires K_6 substituent instead of L_3 . One suggestion that was raised included making claim independent, in which case, the applicants would have to further amend the claims to provide definition for X^- , R_5 and R_6 .

Claim 7 refers to formulae Va, Vb, Vc, Vd or Ve, which are not a limitation of independent claim 1. Formulae Va, Vb, Vc, Vd or Ve are distinct from formula II, since it

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requires K₆ substituent instead of L₃. One suggestion that was raised included making claim independent.

Claim 8 refers to formula VI a, which is not a limitation of independent claim 1. Formula VI a, is distinct from formula II, since it requires K₁, K₂ and K₃ substituent instead of L₃. One suggestion that was raised included making claim independent, in which case, the applicants would have to further amend the claims to provide definition for X⁻, R₅ R₆ and R₇, Q⁺X⁻.

Claim 9, upon deletion of claim 3, the claim 9 would become dependent on claim 1. T₅ and T₆ are defined in claim 9, however, formulae appear to be missing T₁₀. T₁₀ can be H if T₇ is methyl or T₁₀ can be methyl if T₇ is H. Both should be reflected in chemical formulas. R₅ R₆ and R₇ are defined in claim 1.

Claim 10 refers to formulae IIa1, IIb1, IIc1, IId1 or IIe1, appear to be more specific description narrowing down limitation of figure II in independent claim 1. However, formulae IIa1, IIb1, IIc1, IId1 or are distinct from formula II, since it requires K₁, K₂ and K₃ substituent instead of L₃. Additionally limitations of claim 1 do not appear to teach compounds having more than 1 carboxyl functionality. Applicants are requested to clarify the claim or render it independent.

Since the applicants have not incorporated new issues or considerations, there is no reason why the proposed amendment should not be entered. Once discrepancies are corrected, application will be in condition for allowance.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 8:30 AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Katarzyna Wyrozebski/
Primary Examiner, Art Unit 1796
February 5, 2009

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/519,030	Applicant(s) MUHLEBACH ET AL.	
	Examiner Katarzyna Wyrozebski	Art Unit 1796	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: 1 and 3-23.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Katarzyna Wyrozebski/
 Primary Examiner, Art Unit 1796